

REMARKS/ARGUMENTS

In the Restriction Requirement dated January 11, 2008, the Examiner delineated the following inventions as being patentably distinct:

Group I: Claims 1-8, drawn to a transparent sheet; and

Group II: Claims 9-12, drawn to a method of making a transparent sheet.

Applicants provisionally elect with traverse the invention of Group I, Claims 1-8, drawn to a transparent sheet. The claims of Groups I and II are integrally linked as a product, and a method for making said product.

It has been held that product and method for making said product are properly presented as a single invention wherein the sole disclosed utility of the product is that recited in the specification. *Ex parte Brack* (POBA 1961), 134 USPQ 445.

Restriction between a product and a process for the production of said product is proper when the product can be produced by another method. The Examiner has failed to show that other methods can be used for the production of the product.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. Product and method for making are interdependent and should be examined together on the merits, especially wherein the sole disclosed utility is that recited in the specification, 37 C.F.R. § 1.475(b) and unity of invention between the groups exist.

Applicants submit that while PCT Rule 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(e) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to products and the manufacture of said product.” The determination of whether a

group of inventions is so linked as to form a single general inventive concept should be made without regard to whether the inventions are claimed as separate claims or as alternative within a single claim. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Examination Report did not, the restriction is believed to be improper.

Further, M.P.E.P. 803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its own merits even though it includes claims to distinct and independent inventions.


In the instant application the claims of Groups I and II are classified in the same class/subclass so that the invention does not present a burdensome search.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants further request that if the invention of Group I is found allowable withdrawn Group II which includes the limitation of the allowable claims be rejoined.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Paul J. Killos
Registration No. 58,014

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)